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24347 7590 07/20/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1445 Ross Avenue Fountain Place - Suite 3700 DALLAS, TX 75202-2799				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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7  
8 *Ex parte* BRIAN L. JACKSON and CRAIG E. BINGHAM  
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10  
11 Appeal 2008-003068  
12 Application 10/033,943  
13 Technology Center 3600  
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16 Decided:<sup>1</sup> July 20, 2009  
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18  
19 Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,  
20 and ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative*  
21 *Patent Judges*.

22  
23 FETTING, *Administrative Patent Judge*.  
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26 DECISION ON APPEAL  
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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Brian L. Jackson and Craig E. Bingham (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-41, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION<sup>2</sup>

We REVERSE.

THE INVENTION

The Appellants invented a way of natural gas distribution compliance management by maintaining a database identifying compliance events and resources (Specification 5:2-6).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A computerized method for natural gas distribution compliance management, comprising:

[1] maintaining a database identifying

a plurality of compliance events and

a plurality of resources;

[2] providing a computer system including

a main computer and

a remote computer adapted to communicate with

the main computer,

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed February 20, 2007) and Reply Brief ("Reply Br.," filed August 29, 2007), and the Examiner's Answer ("Ans.," mailed November 2, 2007).

at least a portion of a main program and the database  
accessible by the main computer,  
the remote computer accessing a remote program  
operative to display and modify  
only a remote portion of the plurality of  
compliance events and  
only a remote portion of the plurality of resources  
of the database;  
[3] periodically scanning the database to identify at least one of  
the plurality of compliance events requiring a response;  
[4] scanning the database to identify at least one of the plurality  
of resources to respond to the compliance event requiring the  
response;  
[5] matching at least one of the plurality of resources with the  
compliance event requiring the response; and  
[6] scheduling the resource to respond to the compliance event.

#### THE REJECTIONS

The Examiner relies upon the following prior art:

Sturgeon	US 5,726,884	Mar. 10, 1998
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Securities and Exchange Commission, Santa Fe Pacific Corporation  
Annual Report (1992) (hereinafter "Santa Fe").

Claims 1-6, 24-28, and 38-41 stand rejected under 35 U.S.C. § 102(b)  
as anticipated by Sturgeon.

Claims 7-23 and 29-37 stand rejected under 35 U.S.C. § 103(a) as  
unpatentable over Sturgeon and Santa Fe.

#### ARGUMENTS

The Appellants argue independent claims 1, 24, 28, and 38 as a group.  
App. Br. 17. The Appellants rely on these arguments in support of the  
dependent claims for both the rejections under anticipation and obviousness.

Thus, we treat all claims as argued as a group and select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Appellants contend that Sturgeon fails to describe the claim limitations of the remote computer accessing a remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database in limitation [2] and scheduling the resource to respond to the compliance event in limitation [6]. App. Br. 18-19.

The Examiner found that Sturgeon described the remote computer limitation at Sturgeon 10:39-60 (Ans. 3) and 23:60 – 24:40 (Ans. 10) and the scheduling at Sturgeon 32:27-44 (Ans. 4).

## ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 24-28, and 38-41 under 35 U.S.C. § 102(b) as anticipated by Sturgeon turns on whether Sturgeon describes the remote computer and its operations recited in claim 1 limitation [2].

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as unpatentable over Sturgeon and Santa Fe turns on whether the Examiner has shown that Sturgeon suggests the remote computer and its operations recited in claim 1 limitation [2].

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to the Prior Art*

*Sturgeon*

01. Sturgeon is directed to sharing or exchanging information on hazardous substances for in-house and regulatory compliance-related functions using eight functional groupings and a relational database schema or database design that integrates these functional groupings. Sturgeon 9:32-38.

02. Sturgeon describes a Hazardous Commitment Management ("HCM") functional grouping that provides for management of data relevant to hazardous materials-related commitments of an organization and a Hazardous Waste Management ("HWM") functional grouping provides for management of data elements related to the organizations' generation of waste. Dynamic links are maintained among all functional groupings that support the real-time transfer of regulatory agency reporting due dates along with progress toward meeting the reporting due dates. As a consequence, the HCM grouping can be immediately updated with compliance reporting completion information as soon as the final version of the compliance report is run. The dynamic link between the HWM and other groupings provides information on the generation of waste as an output from the production process as soon as the production process transaction is committed. Execution of the waste generation transaction will trigger an

1 immediate update of the HWM grouping and will begin the  
2 countdown of the 90 day RCRA calendar for wastes accumulated  
3 on site without a permit. Sturgeon 10:39-60.

4 03. Sturgeon describes data blocks and fields that illustrate use of  
5 the relational database schema to manage and track hazardous  
6 substance-related information across all flows of paper, work  
7 product, chemicals and complex data, for environmental, health,  
8 and safety monitoring. Sturgeon presents exemplary computer  
9 screen displays in FIGS. 5-45. Each of the computer screens for a  
10 given function is optionally provided with a small block to  
11 indicate whether the sequential position of the screen among  
12 related screens. Sturgeon 23:60 – 24:40.

13 04. Sturgeon describes an Accidental Release Notification that  
14 tracks all events related to a specific accident or other event and  
15 records the circumstances that led to the accident. Sturgeon stores  
16 a list of emergency response contacts as part of the emergency  
17 response planning function and tracks the accident or other event,  
18 as well as the XYZ response to the event. Sturgeon also produces  
19 the follow-up Accidental Release Notification Report and  
20 provides relevant protocols, before the fact, for responses to  
21 unscheduled or excess releases of one or more hazardous  
22 substances. Sturgeon 32:27-44.

23 *Santa Fe*

24 05. Santa Fe is a portion of the Santa Fe Pacific Corp. 1992 annual  
25 report submitted to the SEC.





compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

#### *Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: "[1] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416.

#### ANALYSIS

All four of the independent claims have limitations similar to those argued by the Appellants regarding limitations [2] and [6] of claim 1. While

1 we find that the claim limitations that are performed by the remote computer  
2 of accessing a remote program operative to display and modify only a  
3 remote portion of the plurality of compliance events and only a remote  
4 portion of the plurality of resources of the database fail to specify what the  
5 limitation of “remote” is with respect to regarding the program, events, and  
6 portion of resources, and so the program, events, and portion could indeed  
7 be remote from the remote computer, this leaves the issue of the remote  
8 computer itself unresolved.

9 The independent claims unambiguously require both a main and  
10 remote computer. We are unable to discern any evidence of a remote  
11 computer at the portions cited by the Examiner, or anywhere else in  
12 Sturgeon. The portions cited by the Examiner describe exemplary screen  
13 displays in a display attached to a computer (FF 03) and dynamic links  
14 among the database elements (FF 02).

15 The Examiner provides no findings or explanation showing how these  
16 portions would describe the required remote computer communicating with  
17 the main computer. Thus, we find that Sturgeon fails to describe the remote  
18 computer and its operations recited in claim 1 limitation [2] (FF 06) and the  
19 Examiner erred in presenting a prima facie case of anticipation.

20 The Examiner has also not shown that the secondary reference Santa  
21 Fe suggests this limitation, and we are unable to discern such a suggestion  
22 (FF 06). Thus, we also find the Examiner erred in presenting a prima facie  
23 case of obviousness as to claims 7-23 and 29-37. Because this limitation  
24 requiring a remote computer is substantially present in all claims, the  
25 Examiner’s error extends to rejections of all claims.

As to the argument regarding scheduling in limitation [6], we find that Sturgeon describes performing actions in response to certain stimuli (FF 04) and so the issue resolution hinges on the construction of the limitation “scheduling.” However, because we already found the Examiner failed to present a prima facie case, we need not reach this issue.

#### CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 24-28, and 38-41 under 35 U.S.C. § 102(b) as anticipated by Sturgeon.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as unpatentable over Sturgeon and Santa Fe.

#### DECISION

To summarize, our decision is as follows.

The rejection of claims 1-6, 24-28, and 38-41 under 35 U.S.C. § 102(b) as anticipated by Sturgeon is reversed.

The rejection of claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as unpatentable over Sturgeon and Santa Fe is reversed.

**REVERSED**

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